

REMARKS

The above-noted Restriction Requirement required an election among claims directed to four inventions or groups of inventions (as identified by the Examiner) which are alleged to be not so linked as to form a single general inventive concept under PCT Rule 13.1, as follows:

Group I - Claims 1-4, drawn to a band saw machine having the special technical feature of an upper traveling part and lower traveling part.

Group II - Claims 5-7, drawn to a band saw machine having the special technical feature of a band saw blade introducing mean, and a pair of blade guides.

Group III - Claims 8-12, and 13-17, drawn to apparatus and a method of driving a saw blade, and having the special technical feature of a buffer part, and the step of damping the reaction force.

Group IV - Claims 18-21, drawn to a band saw machine and a method of use having the special technical feature of a main unit vise and moving the sending vise backwards.

According to MPEP Section 803, "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." The above-noted Restriction Requirement does not establish any recognized serious burden that would be imposed on the Examiner in examining each identified group of claims. Nor, given the overlap in features of the various independent claims of each group, is it believed that such a serious burden would be imposed, in that a search for features of the claims of Group III would result in a search for at least some features of claims of Groups

I, II and/or IV. Accordingly, it is requested that the Examiner find that a serious burden would not result if all claims pending in the present application were to be examined, and that the Restriction Requirement therefore be withdrawn.

In view of the foregoing, it is respectfully requested that the Examiner reconsider the Restriction Requirement, and withdraw the same. Nevertheless, in order to be fully responsive, Applicants have elected with traverse Group III (as identified by the Examiner), comprising claims 8-12 and 13-17.

The above-noted Election of Species Requirement required an election between four patentably distinct species (as identified by the Examiner) which are alleged to be not so linked as to form a single general inventive concepts under PCT Rule 13.1, as follows:

Species a - A buffer of resin.

Species b - A buffer of a spring body

Species c - A buffer of a damper device

Species d - A buffer of vibration generating device.

Upon entry of the present paper, Applicants will have elected Species d (as identified by the Examiner), to which at least claims 12 and 17 are directed (with claims 8 and 13 being considered generic to all identified Species).

The Election of Species Requirement does not establish a proper basis for any assertion that unity of invention is lacking under 37 C.F.R. 1.475(a). In this regard, dependent claims 9-12 and 14-17 of the present application each depend, directly or indirectly, from independent claims 8 and 13, respectively. Any special technical features in claims 8 and 13 are present in each of claims 9-12 and 14-17, respectively, by

virtue of their dependence from independent claims 8 and 13. Accordingly, a technical relationship among those Species identified in the Election of Species Requirement should be presumed at least in relation to any special technical features present in claims 8 and 13.

As set forth in MPEP 1850 (II), Determination of Unity of Invention:

Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims (emphasis added).

Accordingly, if independent claims 8 and 13 avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on independent claims 8 and 13, respectively. In particular, no consideration need be given as to whether any dependent claim itself contains a further invention so long as independent claims 8 and 13 avoid the prior art and satisfy the requirement of unity of invention. Of course, the Restriction Requirement makes no assertion that claim 8 and 13 do not satisfy the requirement of unity of invention, and no assertion that claims 8 and 13 do not avoid the prior art. That is, the Restriction Requirement must show a lack of a special technical relationship among those inventions involving the special technical features of claims 8 and 13, though such a lack of a special technical relationship can not be shown at least until independent claims 8 and 13 are shown not to avoid the prior art.

Additionally, the above-noted Election of Species Requirement does not establish any serious burden recognized in the MPEP that would be imposed on the Examiner in examining claims directed to each identified Species (as identified by the Examiner). Nor, given the common dependency of claims directed to different identified Species (as

identified by the Examiner) on generic claims 8 and 13, is it believed that such a serious burden would be imposed, in that a search for features of the claims of Species d would result in a search for at least some features of claims of Species a, b and c which are present in the generic base claims. Accordingly, it is requested that the Examiner find that a serious burden would not result if all claims pending in the present application were to be examined.

In view of the foregoing, it is respectfully requested that the Examiner reconsider the Election of Species Requirement, and withdraw the same. Nevertheless, in order to be fully responsive, Applicants have elected Species d (as identified by the Examiner), to which at least claims 12 and 17 are directed (with claims 8 and 13 being considered generic to all identified Species).

Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully Submitted,
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